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COMMENTS

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Applicant(s): Grigor Markarian, et al.
 Title: METHOD AND SYSTEM FOR CONDUCTING COMMERCE
 OVER A WIRELESS COMMUNICATION NETWORK
 Serial No.: 10/028,718
 Filing Date: December 28, 2001
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Grigor MARFARIAN, et al.

Group Art Unit: 3629

Serial No.: 10/028,718

Examiner: BORISSOV, Igor

Filed: December 28, 2001

For: **METHOD AND SYSTEM FOR CONDUCTING COMMERCE OVER A
WIRELESS COMMUNICATION NETWORK**

BY FACSIMILE - 571-273-8300

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REPLY BRIEF

Dear Sir:

This is a Reply Brief under 37 C.F.R. § 41.41 in connection with the Examiner's
Answer mailed July 5, 2006.

Comments begin on **Page 2**.

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Tompkins Should be Disqualified as a Reference

On page 6 of the Examiner's Answer, the Office submits that the undersigned's attempt to disqualify the Tompkins reference (US 2001/0056401) as being commonly owned with the instant application fails stating:

In response to this argument, Examiner points out that US 2001/0056401 (Tomkins)(sp?) application was assigned to CDC on July 26, 2001. The present patent application was assigned to CDC on April 08, 2002, and has an effective date December 28, 2001. Therefore, contrary to the Applicant's statement, at the time the present invention was made US 2001/0056401 (Tomkin)(sp?) application and present patent application *were not commonly owned* by CDC, and Tompkin (US 2001/0056401) is a prior art under 35 U.S.C. 103(c).

Referring to 35 U.S.C. § 103(c)(1):

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Initially, the undersigned notes that the language of the statute refers to common ownership at the time the invention was made or **subject to an obligation of assignment**. While the undersigned maintains that the present claimed invention and the Tompkins reference were commonly owned by CDC by virtue of the fact that the invention was made by the inventors in conjunction with their employment with CDC, at the very least, they had an obligation to assign and did so within mere months of filing the patent application.

Referring to MPEP § 706.02(1)(2), the undersigned's statement that the Tompkins application and the present invention were commonly owned was clearly set forth in the

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Appeal Brief and should have been sufficient to disqualify the Tompkins references.¹ In

MPEP § 706.02(I)(2)(II), the following example is given (emphasis added):

For example, an attorney or agent of record receives an Office action for Application X in which all the claims are rejected under 35 U.S.C. 103(a) using Patent A in view of Patent B wherein Patent A is only available as prior art under 35 U.S.C. 102(e), (f), and/or (g). In her response to the Office action, the attorney or agent of record for Application X states, in a clear and conspicuous manner, that:

"Application X and Patent A were, at the time the invention of Application X was made, owned by Company Z."

This statement alone is sufficient evidence to disqualify Patent A from being used in a rejection under 35 U.S.C. 103(a) against the claims of Application X.

The undersigned provided additional assignment recordation details along with this statement merely to show that in fact the obligation to assign had been carried out and recorded.

In the Examiner's Answer, the Office now restates the assignment document recordation dates proffering that the resulting chronology rebuts the clear and unambiguous statement by the undersigned. This entire exercise on the part of the Office only confuses what was clear and unambiguous – the Tompkins application and the present application are owned by CDC and the subject matter thereof was always *de facto* owned by CDC since all listed inventors were (and some still are) employees of CDC at the time of the inventions. At the time of invention (both the present invention and the Tompkins application), the inventors had a legal obligation to assign to CDC and did so, officially, in due course.

¹ See MPEP § 706.02(I)(3) Examination Procedure With Respect to 35 U.S.C. 103(c). (Applications and patents will be considered to be owned by, or subject to an obligation of assignment to, the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person(s) or organization(s).)

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Teachings of Tompkins are Misinterpreted by the Office and Unrelated

Even if Tompkins does qualify as prior art, the undersigned fails to see how the teachings of Tompkins in combination with Eerola render the claimed invention obvious. On Page 6 of the Examiner's Answer, the Office admits that the subject matter described in paragraphs [0028] and [0065] is directed to two different embodiments. The Office also makes the following statement:

...these two embodiments each disclose: sending a purchase request from a customer terminal to a merchant website; transmitting a payment authorization request from the merchant website to a bank server which authorizes or denies the transaction; notifying the customer that the transaction has been approved or denied.

The undersigned has carefully reviewed paragraph [0028] and finds no such teachings therein. The Office offers no additional citations from Tompkins to support this statement. Clearly Eerola does not, alone, disclose what is claimed. Tompkins discloses various exemplary embodiments which describe, separately, using a set-top box to bank from home and using a set-top box to initiate purchases with merchants. Importantly, there is no device or method described in either Eerola or Tompkins wherein the same platform handles all requests, transactions, notifications, etc. as claimed. For example, in paragraph [0065] of Tompkins, although the user makes the initial purchase request with the merchant through the set-top box, the merchant communicates directly with the credit card company for the credit authorization step. The merchant request does not pass through the set-top box. Accordingly, this is but one example of a missing claim limitations that is simply not taught in any of the cited references.

Accordingly, the undersigned maintains that even if Tompkins does qualify as prior art, the combination of Eerola and Tompkins does not render the claimed invention obvious.

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CONCLUSION

For the reasons set forth herein, the undersigned submits that the claims are allowable over the cited art and respectfully requests that the Board of Patent Appeals and Interferences direct the Office to issue a notice of allowance to this effect.

Respectfully submitted,

Date: 9/5/06
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